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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/723,323	11/26/2003	Enrico Alessi	364659-1003	9467
32914	7590	10/28/2008	EXAMINER	
GARDERE WYNNE SEWELL LLP			LIN, JERRY	
INTELLECTUAL PROPERTY SECTION				
3000 THANKSGIVING TOWER			ART UNIT	PAPER NUMBER
1601 ELM ST				1631
DALLAS, TX 75201-4761				
			MAIL DATE	DELIVERY MODE
			10/28/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/723,323	ALESSI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	JERRY LIN	1631	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 22 August 2008.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1 and 3-17 is/are pending in the application.
- 4a) Of the above claim(s) 9-12 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,3-8 and 13-17 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ .  | 6) <input type="checkbox"/> Other: _____ .                        |

**DETAILED ACTION**

1. Applicants' arguments, filed August 22, 2008, have been fully considered and they are deemed to be persuasive. The following rejections are newly applied. They constitute the complete set presently being applied to the instant application.

***Status of the Claims***

Claims 1, 3-8 and 13 -17 are under examination.

Claims 9-12 are withdrawn as being drawn to a nonelected invention. The election was made with traverse.

Claim 2 is cancelled.

***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1, 3-8, and 13-17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The instant claims are drawn to a computational method of determining co-regulated and co-expressed genes. However, a method must be tied to another category of invention to be patentable subject matter (For further explanation see, Ex Parte Langemyr (No. 2008-1495, decided 5/28/2008), available at [http://www.uspto.gov/web/offices/dcom/bpai/informative\\_opinions.html](http://www.uspto.gov/web/offices/dcom/bpai/informative_opinions.html)). In the instant

case, the claimed method steps are not tied to another category of invention, and thus are non-statutory.

**Response to Arguments**

4. The instant claims were previously rejected as non-statutory as being drawn to a judicial exception without a practical application. Applicants have amended the claims to include a step of outputting to a user which provides a practical application to the claimed judicial exception. However, the instant process claims do not recite a tie to another category of invention, and thus are must be rejected as non-statutory. This is a new grounds of rejection.

***Withdrawn Rejections***

5. Applicant's arguments, filed December 17, 2007, with respect to the rejection made under 35 U.S.C. §103 as being unpatentable over Quackenbush, Getz et al., Dougherty et al. and Tolley have been fully considered and are persuasive. Quackenbush does not teach pairing clusters if the characteristic parameter is larger than a threshold, and the combinations of Getz et al. are not a pair combination of two datasets of genes. This rejection has been withdrawn.

***Conclusion***

No claim is allowed.

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JERRY LIN whose telephone number is (571)272-2561. The examiner can normally be reached on 7:00-5:30pm, M-TH.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marjorie A. Moran can be reached on (571) 272-0720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jerry Lin/  
Examiner, Art Unit 1631  
10/25/08